

Patent
Attorney Docket: AUS920010629US1
(IBM/0026)

REMARKS

Applicant thanks the Examiner for conducting a telephone interview regarding the issues in the pending office action. The remarks that follow include all the issues discussed during the interview.

Claim 1 stands rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant has amended claim 1 to remove the reference to automatically receiving a customer identification record as being unduly restrictive.

Claims 1-44 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,724,412 issued to Srinivasan. Srinivasan discloses a method and system for providing a callee with internet information related to a caller attempting to call the callee. (Srinivasan, Abstract). The internet information, as well as the caller's name and telephone number, may be supplied to the callee during the first 2 rings of the telephone and, if the call is not completed, then the callee may obtain the information at a later time. (Srinivasan, Abstract).

The central telephone office of the caller maintains records to supply for caller ID purposes when a caller calls a callee. (Srinivasan, col. 2, lines 20). Assuming there is internet information concerning the caller, then this information is provided as part of the caller-ID system when the caller calls the callee. *Id.* Internet information that may be included in the caller-ID include one or more of the caller's email address, the caller's URL location, a Gopher address, a WAIS address and a FTP address. (Srinivasan, col.1, lines 50-56).

If the callee is not home or not available when the caller calls, the callee can obtain the information at a later time by calling the caller information manager 54 to obtain information about the caller. (Srinivasan, col. 8, lines 1-30). Here, the caller must enter a user ID and password so that the caller information manager 54 can validate the identity of the callee before revealing the information about the caller. *Id.*

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Applicant claims providing a URL to a customer, comprising, *inter alia*, receiving a customer identification record including a destination address associated with a communications terminal of the customer during a telephone call with the customer; selecting at least one URL to be sent to the destination address of the customer. (Claims 1, 15, 17, 18 and 31).

MPEP § 2131 provides:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, *i.e.*, identity of terminology is not required. *In re Bond*, 910 F.2d 831 (Fed. Cir. 1990).

Applicant respectfully asserts that a *prima facie* case of anticipation has not been presented because the cited prior art fails to find each and every element as set forth in the claims. In particular, the cited prior art fails to disclose sending at least one URL to the destination address of the customer. In support of the rejection of this element, the Examiner cites Srinivasan as disclosing that the Internet information of the caller may include, *inter alia*, the caller's email address and the caller's URL at Srinivasan, col. 1, line 34 to col. 2, line 14. (Office Action, p. 3). However, the URL of the *caller* being used as an address of an electronic message being sent to the caller is not what Applicant claims.

Since Srinivasan does not disclose sending a selected URL to the destination address of the customer, Applicant respectfully requests reconsideration and withdrawal of the rejection of independent claims 1, 15, 17, 18 and 31 as well as of all claims depending therefrom.

Regarding claims 2, 19 and 32, Applicant claims that the electronic message additionally contains items selected from an electronic coupon, an on-line trial subscription, a user ID, a user password, advertisements, merchant information or combinations thereof,

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wherein the user ID and user password are required by the website having the address of the URL. (Claims 2, 19, 32). In support of the rejection of this element, the Examiner cites Srinivasan as disclosing that the callee provides the caller information manager with identification information such as a user ID and password which the caller information manager, in turn, uses as input to the caller-ID manager. (Office Action, p. 3). However, such is not what Applicant claims. The electronic message sent to the caller as claimed by Applicant contains information such as the password and user ID necessary *for the caller* to enter the website of the URL being sent to the caller in the electronic message. This is not the same as the *callee* calling the callee's telephone mailbox and entering his ID and password so that the *callee* can enter and website to retrieve his messages, as disclosed by Srinivasan.

Since Srinivasan does not disclose that the electronic message additionally contains items selected from an electronic coupon, an on-line trial subscription, a user ID, a user password, advertisements, merchant information or combinations thereof, wherein the user ID and user password are required by the website having the address of the URL, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 2, 29 and 32.

Regarding claims 17 and 18, Applicant claims that the electronic message containing the selected URL is sent or received by/from the telephone system of the sender. Srinivasan is silent as to the telephone system of the callee sending any internet message to the caller.

Since Srinivasan does not disclose that the electronic message containing the selected URL is sent by or received from the telephone system of the sender, Applicant respectfully requests reconsideration and withdrawal of the rejection of independent claims 17 and 18 as well as of all claims depending therefrom.

Applicant respectfully requests that all the amendments above be entered pursuant to 37 CFR 1.116 to correct certain informalities in the claims and to place the claims in better form for consideration on appeal. In the event there are additional charges in connection with the filing of this Response, the Commissioner is hereby authorized to charge the Deposit

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Account No. 50-0714/IBM/0026 of the firm of the below-signed attorney in the amount of any necessary fee.

Respectfully submitted,

STREETS & STEELE



Frank J. Campigotto
Attorney for Applicant
Registration No. 48,130
13831 Northwest Freeway, Suite 355
Houston, Texas 77040
(713) 939-9444